



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent Application of:
Moore et al.

Docket No.: PF466

Application No.: 09/263,626

Group Art Unit: 1646

Filed: March 5, 1999

Examiner: Brannock, M.

For: Cytokine Receptor Common Gamma Chain Like

PROVISIONAL ELECTION UNDER 37 C.F.R. § 1.143

Commissioner for Patents
Alexandria, VA 22313

Dear Sir:

In response to the Office Action dated May 16, 2003, please consider the following provisional election, and remarks. Applicants submit concurrently herewith (a) a Fee Transmittal Sheet with appropriate fee; and (b) an Information Disclosure Statement attaching form PTO/SB/08 and copies of references AT-AZ.

Claims 25-50, 60-98, 100-124, 126-131, 133-150, and 154-155 are pending.

The Restriction Requirement

Pursuant to Paper No. 30, mailed May 16, 2003, the Examiner has required an election of species (presumably under 37 C.F.R. § 1.146) of one of the species comprising polynucleotides encoding specific fragments of SEQ ID NO:2. The Examiner contends that the species are patentably distinct. The Examiner has also noted that claims 37-40, 76-98, 129-131, 140-150, and 154-155 are generic to the plurality of allegedly patentably distinct species.

In order to be fully responsive, Applicants provisionally elect the subject matter of a polynucleotide encoding residues 1 to 231 of SEQ ID NO:2, represented by at least claims 37, 39, 77, 81, 129-131, 140-141, 143-150, and 154-155. Applicants reserve the right to file one or more divisional applications directed to the non-elected species should the restriction requirement be made final.

Preliminarily, Applicants point out that the specification teaches that residues 1-231 are the predicted extracellular soluble portion of the CRCGCL polypeptide (*see, e.g.,*

Example 10 at page 80, lines 17-18), and that residues 23 to 225 are the predicted extracellular domain (*see, e.g.*, page 7, lines 28-29, and page 2, lines 24-25). Applicants believe that the examination of polynucleotides encoding such polypeptides together with the claims to polynucleotides encoding the full-length and mature polypeptides is consistent with Office policy.

However, pursuant to MPEP § 809.02, the generic claims identified by the Examiner (claims 37-40, 76-98, 129-131, 140-150, and 154-155) must be examined. If the generic claims are allowable, claims directed to a reasonable number of species should be allowed with the generic claims. Applicants are also "entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141." MPEP § 809.02(a). As the Examiner has indicated that all of claims 37-40, 76-98, 129-131, 140-150, and 154-155 are generic, and claims 38, 76-98, 129-131, 141-150, and 154-155 depend variously from generic claims 37, 39-40, and 140, none of these claims may be withdrawn.

Moreover, Applicants note that the Examiner is requiring an election of the members of Markush-type claims (37, 39, and 40). Applicants respectfully point out that MPEP § 803.02 requires that "[i]f the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits." Applicants submit that the members of the Markush groups of the pending claims are sufficiently few in number and very closely related, as they are all portions of the same amino acid sequence, so that a search of all of the members may be made without a serious burden, contrary to the Examiner's position. Moreover, even assuming that examination of the entire claim would present a serious burden, MPEP § 803.02 states that "[f]ollowing election, the Markush-type claim will be examined fully as to the elected species and further to the extent necessary to determine patentability." If no prior art is found "that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended." *Id.* (emphasis added).

Accordingly, in view of the foregoing, all of claims 37-40, 76-98, 129-131, 140-150, and 154-155 should be searched and examined in the present application. Applicants therefore respectfully request that the requirement for an election of a species within the previously elected group be reconsidered and either amended or withdrawn, and that the

instant claims be examined. Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

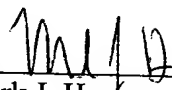
Conclusion

The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicants would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

Dated: June 16, 2003

Respectfully submitted,

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